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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,411	01/02/2001	Eric D. Bergman	0007056-0053/P5278/ARG	3148

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EXAMINER
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HUYNH, CONG LAC T

ART UNIT	PAPER NUMBER
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2178

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/754,411

Applicant(s)

BERGMAN ET AL.

Examiner

Cong-Lac Huynh

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is responsive to communications: the application filed on 1/2/01.
2. Claims 1-24 are pending in the case. Claims 1, 9, 17 are independent claims.

#### *Claim Objections*

3. Claim 16 is objected to because of the following informalities: the dependency of claim 16 is incorrect since claim 16 is dependent on claim 1, but refers to a change tracker which is mentioned in independent claim 9. Appropriate correction is required.
4. Claim 9 is objected to because of the following informalities: the "an" in the phrase "An change tracker comprising: ..." is not correct. Appropriate correction is required.

#### *Claim Rejections - 35 USC § 101*

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 9-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a change tracker, which is not a process, machine, manufacture, or composition of matter, and so, are non-statutory.

A change tracker which includes an original document configured to be created on a computer and transferred to a disconnected device, a modified document, and a change tracker configured to determine one or more modifications where the original document, the modified document and a change tracker are data structures but not claimed as

embodied in computer-readable media. Therefore, said data structures are descriptive material per se and are not statutory. See MPEP 2105.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-8, 17-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding independent claim 1, it is unclear how to carry out "modifying said original document *on said disconnected device* to form a modified document" since a computer or any computer-based device, when disconnected that means unplugged, can not load documents to modify.

Independent 17 is rejected under the same issue.

Dependent claims 2-8, 18-24 are rejected for fully incorporating the deficiencies of their base claim.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1-3, 5-11, 13-19, 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sragner (US Pat No. 6,272,485 B1, 8/7/01, filed 2/19/99).

Regarding independent claim 1, Sragner discloses:

- creating an original document on a computer (col 1, lines 17-24, col 2, lines 52-54, col 2, line 66 to col 3, line 7: documents transferred from central document server to remote document users suggests that the document is already created at a central computer)
- transferring said original document to a disconnected device (col 1, lines 17-24, col 2, lines 52-54, col 2, line 66 to col 3, line 7, col 5, lines 1-7; it is noted that the computer at the remote terminal, when unplugged or turned off is considered as a disconnected device while the original is transferred to it)
- modifying said original document on said disconnected device to form a modified document (col 1, lines 17-24, col 5, line 63 to col 6, line 3, col 8, lines 9-18: edit

- the received document at the client computer; col 3, lines 42-46: modify the received document by entering data into data fields of the document at the client)
- returning said modified document to said computer (col 8, lines 9-18, col 3, lines 1-7, 42-46)

Sragner does not explicitly disclose determining one or more modification between said original document and said modified document.

Instead, Sragner discloses that the present invention as well as the various embodiments of the invention include methods and systems which send documents from the central server to a remote user where the user can modify the received documents and return to the central server (col 3, lines 30-46).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Sragner to include determining one or more modification between said original document and said modified document since the fact that entering data into the data fields of the received document, which is the original document, shows one modification between the original document and the modified document.

Regarding claim 2, which is dependent on claim 1, Sragner discloses utilizing change tracking software (col 8, lines 18-26: the fact that the CGI data extracting script that *reads the data entered into the data fields and update the database file with the extracted data* by opening and amending the database file suggests a change tracking software since the entered data to the document is the change to the document, and the system via extracting scripts recognize such change to amend the database file).

Regarding claim 3, which is dependent on claim 1, Sragner discloses utilizing a data translation operation (col 8, lines 18-26: as mentioned in claim 2, reading the data entered into the data fields and update the database file with extracted data are data translation operations).

Regarding claim 5, which is dependent on claim 1, Sragner discloses integrating said modifications into said original document (col 3, lines 42-46: the entered data to the data fields is the modification integrated to the received document, which is the original document, col 8, lines 15-17: the fact that the blank fields are inserted with data shows the modification integrated into the original document). Sragner does not explicitly disclose determining whether to integrate said modification into said original document. However, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to have modified Sragner to include said determining since said integrating is performed suggests determining a decision of integrating said modifications into said original document be carried out before actually integrating.

Regarding claim 6, which is dependent on claim 1, Sragner discloses merging said original document and said modified document (col 3, lines 1-7, 42-46, col 8, lines 9-18: the fact that the original document is modified and returned to the central server that includes the original document suggests merging said original document and said modified document since the returned document by itself is a modified document of merging of the original document and data).

Regarding claim 7, which is dependent on claim 1, Sragner discloses said original document was created using an office productivity application (col 3, lines 18-21: the documents are made available in plural formats of Microsoft Word, WordPerfect, Microsoft Excel...).

Regarding claim 8, which is dependent on claim 1, Sragner discloses said document was modified using a companion application (col 5, line 63 to col 6, line 3: using word processor, spreadsheet to edit documents).

Claims 9-11, 13-16 are for a change tracker of method claims 1-3, 5-8, and are rejected under the same rationale.

Claims 17-19, 21-24 are for a computer program product of method claims 1-3, 5-8, and are rejected under the same rationale.

12. Claims 4, 12, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sragner as applied to claim 1, 9, 17 above, and further in view of in view of Oprescu-Surcobe (US Pat No. 6,356,961 B1, 3/12/02, filed 6/3/94).

Regarding claim 4, which is dependent on claim 1, Sragner does not disclose that said disconnected device comprises a PDA.

Oprescu-Surcobe discloses that individuals can transmit, receive, write to modification to a document to create an edited version and the edited version can be communicated



back to the source and to other devices on the network (col 1, lines 38-43). Oprescu-Surcobe also discloses that the devices where to perform the above operations can be computer based devices such as personal computer, desktop computers, or personal digital assistants (PDAs).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Oprescu-Surcobe into Sragner for expanding the use of different computer-based devices, e.g. PDA, to perform various operations on documents, not limited to personal computer, which is a conventional device.

Claims 12 and 20 are for a change tracker and a computer program product of method claim 4, and are rejected under the same rationale.

#### *Conclusion*

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Malcolm (US Pat No. 6,006,204, 12/21/99, filed 12/18/97).

Beattie et al. (US Pat No. 6,457,002 B1, 9/24/02, filed 4/11/01, priority 7/8/97).

Moriya (US Pat No. 6,161,140, 12/12/00, filed 9/30/97).

Kelly (US Pat No. 6,442,595 B1, 8/27/02, filed 12/22/99).

Hishida et al. (US Pat No. 6,477,549 B1, 11/5/02, filed 10/5/98).

Maslov (US Pat No. 6,538,673 B1, 3/25/03, filed 4/13/00).

Lee et al. (US Pat No. 6,363,381 B1, 3/26/02, filed 11/3/98).

Peairs et al. (US Pat No. 6,199,073 B1, 3/6/01, filed 9/26/97).

Meding (US Pat No. 6,647,156 B1, 11/11/03, filed 6/14/00).

Muranaga et al. (US Pat No. 5,671,428, 9/23/97, filed 8/28/92).

Kamba et al., Using small screen space more efficiently, ACM 1996, pages 383-390.

Hodes et al., Composable ad hoc location-based services for heterogeneous mobile clients, Wireless Networks 1999, pages 411-427.

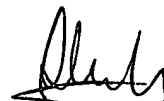
Pope et al., Using the web for peer review and publication of scientific journals, Google September 1998, pages 1-10.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 703-305-0432. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 703-308-5186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Clh  
4/16/04

  
STEPHEN S. HONG  
PRIMARY EXAMINER